

Application No. 10/005,804
Amendment dated September 29, 2005
After Final Office Action of July 18, 2005

Docket No.: 47309-00031USP1

REMARKS

Claims 1-2, 4-5, 8-9, 12-13, 15-16, 18-19, 26, 34-36, 39, 43-44, and 77-131 are presently pending. Claims 8-9, 12, 15-16, 18, 26, 34-36, 39, 44, 81-83, 85-91, 93, 98-102, 104-110, 112, 117-120, 123-128, and 130 have been amended. Claims 1-2, 4-5, 19, 77-80, 92, 94-97, 113-116, 129, and 131 have been cancelled. Thus, claims 8-9, 12-13, 15-16, 18, 26, 34-36, 39, 43-44, 81-91, 93, 98-112, 117-128, and 130 remain pending in the present application.

The Examiner is thanked for the courtesies extended to Applicants' attorneys Janet Garetto and Ela Wiszowaty during a brief telephone interview held on August 25, 2005. During the interview, Applicants' attorneys requested clarification of the 35 U.S.C. § 112, second paragraph rejection. The Examiner suggested that Applicants clarify the language "a wood-boring pesticidally effective amount of pesticide", and Applicants suggested the alternative language "a pesticidally effective amount of at least one pesticide for wood pests." The Examiner also suggested that the Applicants identify support in the specification for the "substantially no" and "minute amounts" language.

The Examiner has withdrawn claim 131 from consideration as being directed to a non-elected invention under 37 C.F.R. 1.142(b). To expedite prosecution, Applicants have cancelled claim 131.

The Examiner has withdrawn claims 1, 2, 4-5, 9, 12-13, 16, 18, 26, 34-36, 39, 43-44, 77-80, 83-84, 86-97, 101-103, 105-116, 120-122, and 124-130 from further consideration pursuant to 37 C.F.R. 1.142(b). Applicants have cancelled claims 1-2, 4-5, 77-80, 92, 94-97, 113-116, and 129. Applicants believe that the remaining claims 9, 12-13, 16, 18, 26, 34-36, 39, 43-44, 83-84, 86-91, 93, 101-103, 105-112, 120-122, 124-128, and 130 are allowable for the reasons set forth below.

The Examiner has indicated that the language "wood-boring pesticidally," "substantially no," and "minute amounts" do not satisfy the requirements set forth in 35 U.S.C. § 112, second paragraph. In accordance with the items discussed with the Examiner, Applicants have amended the "wood-boring pesticidally" language to "pesticidally effective amount of at least one pesticide for wood pests." Applicants submit that support for the "substantially no" or "minute amounts" language may be found in the specification at, *inter alia*, page 15, lines 13-15,

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which states, "The phrases 'substantially no release' and 'releasing only minute amounts' are intended to define a release rate less than $0.4 \mu\text{g}/\text{cm}^2/\text{day}$, preferably less than $0.1 \mu\text{g}/\text{cm}^2/\text{day}$, and most preferably less than $0.05 \mu\text{g}/\text{cm}^2/\text{day}$."

In the Office Action, the Examiner has indicated that claims 26, 87, 107 and 125 would be allowable if rewritten to overcome the 35 U.S.C. 112, second paragraph rejection. The Applicants thank the Examiner for his indicated allowability of claims 26, 87, 107, and 125. To expedite prosecution, Applicants have amended and rewritten claims 26, 87, 107, and 125 into independent form.

Specifically, claim 26 has been amended to incorporate the limitations of cancelled claims 1-2, from which it previously depended. Thus, claim 26 and its dependent claims 9, 12-13, 16, 18, 34-36, 39, and 43-44 are believed to be allowable.

Claim 87 has been amended to incorporate the limitations of cancelled claims 77-78, from which it previously depended. Thus, claim 87 and its dependent claims 83-84, 86, 88-91, 93 are believed to be allowable.

Claim 107 has been amended to incorporate the limitations of cancelled claims 94-95, from which it previously depended. Thus, claim 107 and its dependent claims 101-103, 105-106, and 108-112 are believed to be allowable.

Claim 125 has been amended to incorporate the limitations of cancelled claims 113-114, from which it previously depended. Thus, claim 125 and its dependent claims 120-122, 124, 126-128, and 130 are believed to be allowable.

Furthermore, as indicated above, Applicants believe that claims 26, 87, 107, and 125, as amended, have overcome the 35 U.S.C. 112, second paragraph rejection.

Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. 112, second paragraph rejection and reinstate remaining dependent claims 9, 12-13, 16, 18, 26, 34-36, 39, 43-44, 83-84, 86-91, 93, 101-103, 105-112, 120-122, 124-128, and 130.

Claims 1, 4-5, 9, 12-13, 16, 18, 39, 94-97, 101, 105-106, 110, and 112 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Crook et al. (U.S. Patent No. 6,224,957). Claims 1, 4-5, and 94-97 have been cancelled. In view of the fact that all of the remaining pending claims now depend from allowable claims 26, 87, 107, or 125, Applicants believe this rejection under 35 U.S.C. 103(a) is deemed moot. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

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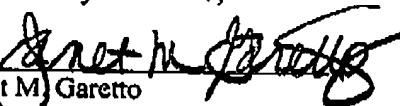
Docket No.: 47309-00031USP1

Claims 1-2, 4-5, 8-9, 12-13, 15-16, 18, 34-36, 39, 43-44, 77-86, 88-106, 108-124, and 126-130 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (U.S. Patent No. 4,639,393) in view of Martinet (AU 13886/95), Dohrer (U.S. Patent No. 4,680,328), and Van Voris (U.S. Patent No. 5,801,194). Claims 1-2, 4-5, 77-80, 92, 94-97, 113-116, and 129 have been cancelled. In view of the fact that all of the remaining pending claims now depend from allowable claims 26, 87, 107, or 125, Applicants believe this rejection under 35 U.S.C. 103(a) is deemed moot. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

In view of the above amendments, Applicants believe the pending application is in condition for allowance. Applicants look forward to the receipt of the Examiner's Advisory Action. It is Applicants' belief that no further fees are due at this time. However, should Applicants be mistaken, the Commissioner is authorized to charge any fees that may be required (except for payment of the issue fee) to Jenkens & Gilchrist, P.C., Deposit Account No. 10-0447, Order No. 47309-00031USP1. A duplicate copy of this paper is enclosed.

Dated: September 29, 2005

Respectfully submitted,

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